

REMARKS

35 USC §103

Claims 1, 3, 6, 11-15 and 59 are rejected under 35 USC §103(a) as being unpatentable over Kennedy et al (US 6506497) in view of Lu et al. (WO 03/088343) as evidenced by Kennedy et al. (US Patent Publication 2007/0272123).

Claims 1, 27 and 29-31 are rejected under 35 USC §103(a) as being unpatentable over Kennedy et al (US 6506497) in view of Lu et al. (WO 03/088343) as evidenced by Kennedy et al. (US Patent Publication 2007/0272123) and Thies et al (US 2009/0029145).

Claims 1, 3, 11-13, 18, 26, 28-31 and 37 are rejected under 35 USC §103(a) as being unpatentable over Ravichandran et al (US 6677392) in view of Hayashi et al (US Patent Publication 2003/0091838), and further in view of Baldwin et al. (US Patent Publication 2002/0068181).

Claims 1 and 37 are rejected under 35 USC §103(a) as being unpatentable over Kennedy et al (US 6506497) in view of Dammel et al. (US Patent Publication 2004/0166434).

The Applicant respectfully disagrees.

It is unclear why the Examiner is including the Lu reference in this prosecution. The Lu reference is directed to and claims porous silica dielectric materials where new porogens are disclosed. There are no organic absorbing compounds included in the reference, despite the Examiners unsupported assertion on page 4, line 2 of the office action. In addition, the compositions claimed and disclosed in the current application relate to absorbing compositions and resulting absorbing layers and coatings. There is absolutely nothing in Lu that would lead one of ordinary skill in the art to consider this reference as applicable or necessarily helpful when developing the absorbing compositions disclosed in the current application. The fact that Lu discloses silicon-based prepolymers and porogens is not enough to make this reference applicable to the current case. The

Examiner must provide additional details as to why this reference is applicable other than a mere reference of “organic absorbing compound” with no citation as to the Lu reference. The Examiner states on Page 9 of the office action that the Lu reference is relied upon to teach TMAA in a spin on composition; however, the Examiner fails to mention that no one of ordinary skill in the art would consider a reference related to porous silica dielectrics to be applicable to defining absorbing compositions comprising organic absorbing compounds. The chemistry is completely different. Merely throwing the Lu reference in only contributes to the Applicants contention that the Examiner is using hindsight to reject these claims and not considering the fact that these materials are completely different and used completely differently.

The Federal Circuit has stated that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” (See *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). The Patent Office applies the same standard. “When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper...Absent such reasons or incentives, the teachings of the references are not combinable.” (See *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (BPAI 1986)). The Federal Circuit crystallizes this concept by the following ruling:

“It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (See *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

Close adherence to this standard is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.” (See *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)(citing *W. L. Gore & Assocs. v. Garlock, inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). In addition, a general relationship between fields of the prior art patents to be combined is insufficient to establish the suggestion or motivation. (See *Interactive Techs., Inc. v. Pittway Corp.*, Civ. App. No.: 98-1464, slip op. at 13 (Fed. Cir. June 1, 1999)(unpublished), cert. denied, 528 U.S. 1046 (1999)). As stated by the Federal Circuit:

“The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some “teaching, suggestion or reason” to combine cited references... When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously.” (*McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)(citing *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997)).

Failure of the Examiner to provide the necessary suggestion or motivation will create a presumption that the combination of references selected by the Examiner to support the obviousness rejection was based on hindsight. (Irah H. Donner, *Patent Prosecution, Practice & Procedure Before the U.S. Patent Office*, Third Edition) In this case, the Examiner fails to point out how one of ordinary skill in the art would read Lu and determine that an absorbing composition can be developed that contains the components in the claims of the present application. The Lu reference should be removed as a reference in this prosecution, as it is simply not applicable to this case.

With respect to the remaining rejections, claim 1 as amended recites:

“An absorbing composition comprising at least one inorganic-based compound, at least one organic-based absorbing compound, and at least one material modification agent, wherein the at least one material modification agent comprises at least one adhesion promoter and at least one crosslinking agent, at least one porogen, at least one catalyst, at least one capping agent, at least one pH tuning agent or a combination thereof, wherein the at least one adhesion promoter comprises APTEOS triflate, APTEOS methanesulfonate, APTEOS nitrate, APTEOS nfb, ammonium triflate, ammonium nfb, ammonium methanesulfonate, ammonium nitrate, TMAH triflate, TMAH nfb, TMAH methanesulfonate, TMAA, TMAN, TMAH nitrate or a combination thereof, wherein the at least one adhesion promoter does not initiate crosslinking activity in the composition and wherein the absorbing compound absorbs light over at least an approximately 10 nm wide wavelength range at wavelengths less than 375 nm and wherein the at least one organic absorbing compound comprises anthraflavic acid, 9-anthracene carboxylic acid, 9-anthracene methanol, alizarin, quinizarin, primuline, 2-hydroxy-4(3-triethoxysilylpropoxy)-diphenylketone, rosolic acid, triethoxysilylpropyl-1,8-naphthalimide, 9-anthracene carboxy-alkyl triethoxysilane, phenyltriethoxysilane, 10-phenanthrene carboxy-methyl triethoxysilane, 4-phenylazophenol, 4-ethoxyphenylazobenzene-4-carboxy-methyl triethoxysilane, 4-methoxyphenylazobenzene-4-carboxy-methyl triethoxysilane or mixtures thereof.”

Please note that the at least one material modification agent requires at least one adhesion promoter and at least one crosslinking agent, at least one porogen, at least one catalyst, at least one capping agent, at least one pH tuning agent or a combination thereof. In addition, claim 10 is canceled and incorporated into claim 1. Claim 10 is not cited in any of the 103(a) rejections, and none of the cited references – alone or in combination teach the following:

- the at least one material modification agent requires at least one adhesion promoter

and at least one crosslinking agent, at least one porogen, at least one catalyst, at least one capping agent, at least one pH tuning agent or a combination thereof;

- the at least one organic absorbing compound comprises anthraflavic acid, 9-anthracene carboxylic acid, 9-anthracene methanol, alizarin, quinizarin, primuline, 2-hydroxy-4(3-triethoxysilylpropoxy)-diphenylketone, rosolic acid, triethoxysilylpropyl-1,8-naphthalimide, 9-anthracene carboxy-alkyl triethoxysilane, phenyltriethoxysilane, 10-phenanthrene carboxy-methyl triethoxysilane, 4-phenylazophenol, 4-ethoxyphenylazobenzene-4-carboxy-methyl triethoxysilane, 4-methoxyphenylazobenzene-4-carboxy-methyl triethoxysilane or mixtures thereof;
- **the at least one adhesion promoter does not initiate crosslinking activity in the composition;**
- ***the at least one adhesion promoter comprises*** APTEOS triflate, APTEOS methanesulfonate, APTEOS nitrate, APTEOS nfb, ammonium triflate, ammonium nfb, ammonium methanesulfonate, ammonium nitrate, TMAH triflate, TMAH nfb, TMAH methanesulfonate, TMAA, TMAN, TMAH nitrate or a combination thereof.

The Examiner addresses these individually, but the Examiner knows that the claims must be read as a whole; and therefore, the Examiner is taking each of these pieces individually and not considering them all together. For example, the Examiner contends that the mere mention of ammonium compounds in Hayashi means that one of ordinary skill in the art would consider them for the absorbing compositions of the present application. Again, this appears to be a case where the Examiner is pulling individual pieces from references and putting them together to form the claims, but not considering that the technology is completely different. Stating that since Hayashi mentions these ammonium compounds that one of ordinary skill in the art producing different compositions would consider them is not proper, since the assumption of chemical interactions cannot be assumed when the underlying constituents of the composition are different.

It is clear that none of these references teach alone or in combination with one another the provisions of claim 1 to anyone of ordinary skill in the art. Therefore, claim 1 is allowable over all of the cited references. In addition, claims 3, 6, 11-15, 18, 26-31, 37 and 59 are allowable as patentable over all of the cited references, by virtue of their dependence on claim 1.

REQUEST FOR AN INTERVIEW

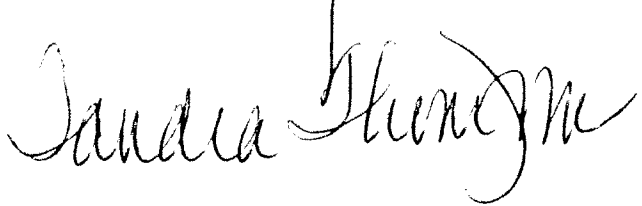
A Request for Interview form is attached herein. The Applicant explicitly requests an interview with the Examiner if this application is not put in condition for allowance. There may be claims amendments that the Examiner can enter at this stage that will allow this case to proceed to allowance, if it doesn't already.

REQUEST FOR ALLOWANCE

Claims 1, 3, 6, 11-15, 18, 26-31, 37 and 59 are pending in this application. The applicants request allowance of all pending claims.

Respectfully submitted,

Buchalter Nemer, A Professional Corp.

A handwritten signature in black ink, appearing to read "Sandra Thompson". The signature is fluid and cursive, with the first name "Sandra" written in a larger, more prominent script than the last name "Thompson".

Dated: November 1, 2010

By:

Sandra P. Thompson, PhD, Esq.

Reg. No. 46,264

E-mail: patent@buchalter.com

Direct Line: 949-224-6282

ATTORNEYS FOR APPLICANT(S):

Buchalter Nemer, A Professional Corporation
18400 Von Karman Ave., Suite 800
Irvine, CA 92612
Fax: 949-720-0182